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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,331	04/08/2004	Harald Schmitzer	DT-6788	8547
30377	7590	07/06/2006		
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/820,331	Applicant(s) SCHMITZER ET AL.	
	Examiner Michelle Lopez	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/03/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the limitations “the workpiece” in line 2 and “the connection” in line 3, lack antecedent basis.

In claim 2, it is not clear what is meant by a “discrete” switch.

In claim 4, “axially limited manner” is indefinite in that such movement is not tied to any other part in the claim.

In claim 5, the limitations “the control”, “the workpiece”, “the electric motor”, “the force sensor”, and “the pressing force” lack antecedent basis.

In claim 6, the limitation “the sensitivity” lacks antecedent basis. Also, it is not clear what is meant by “the sensitivity of the control”, and with respect to what does the sensitivity “increases progressively”.

In claim 8, it is not clear what is a “negative force”. Also, “the amount of negative force” lacks antecedent basis.

Claim 12 is indefinite in that is not clear what does applicant mean by “alternating with the first step”.

In claim 14, it is not clear what is meant by “less than a minimum force over an idling period”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Giardino 6,892,826.

Giardino discloses a hand held electric tool with a tool receptacle for a tool and a press switch, i.e. a trigger 16, arranged at a handle, a power source, an electric motor connected to control electronics 50 that are connected to a force sensor 30, wherein said force sensor 30 is arranged between the tool receptacle and the handle and measures a pressing force of the machine tool pressing against a workpiece.

With respect to claim 2, it is deemed that Giardino is a discrete switch as broadly claimed.

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With respect to claim 3, Giardino discloses wherein the control electronics are controllably connected to a mode selector switch via input device 68.

With respect to claim 5, Giardino discloses a control process for a rotary operating mode for rotating a tool receptacle for a tool, wherein a control 50 is activated in a first step by actuating a trigger 16, and in a second step, the control 50 controls an electric motor depending on a force measured by a force sensor 30.

As far as claim 6 was understood, Giardino discloses wherein the control 50 controls the electric motor depending on an activation period of a force measured by the sensor as shown in col. 4; 35-38.

With respect to claim 7, since Giardino discloses an input device 68 wherein an operator may input a preselected torque value, it is deemed that the control 50 always controls the electric motor above a minimum rotational speed which is dependent upon an operating mode selected by the operator as shown in col. 7; 24-29.

As far as claim 8 was understood, it is deemed that Giardino control 50 controls the electric motor when a preselected torque level is reached.

With respect to claim 9, the control 50 is activated and deactivated by activation of the trigger 16.

With respect to claim 10, Giardino discloses wherein the electric motor is controlled independent from the force measured by the force sensor in an operation mode selected by the operator as shown in col. 7; 24-29.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giardino 6,892,826.

With respect to claim 4, Giardino discloses wherein a hammer element is provided axially displaceable with respect to the tool receptacle, but does not specifically disclose wherein the hammer is displaceable by a maximum of 1 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provided a displacement as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

With respect to claim 11, Giardino discloses a non-rotary operating mode as an impact mechanism described in col. 2; 63-67 and col. 3; 1-13, wherein the activation of the control is carried out by a triggering actuation and a release of the press switch 16 within a determined period, but does not specifically disclose that such period is less than 0.5 seconds. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provided a period of time as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

As far as claim 12 was understood, Giardino discloses wherein the control is deactivated over a time period between repeated activations of the trigger 16, wherein said time period is

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preselected by an operator via input device 68, but does specifically disclose wherein said time period is of a maximum of 0.5 seconds. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provided a period of time as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

With respect to claim 13, Giardino discloses a non-rotary operating mode as an impact mechanism described in col. 2; 63-67 and col. 3; 1-13, wherein the activation of the control is carried out at a force peak measured by the force sensor at greater than a preselected force or torque within a trigger activation period, but does not specifically disclose wherein said period is less than 0.5 seconds. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provided a period of time as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

With respect to claim 14, the control 50 is activated and deactivated by activation of the trigger 16.

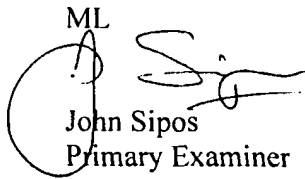
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Breitenmoser, Schaer, Noser, Bookshar, Bongers-Ambrosius, Suzuki, Watanabe, Cripe, Frauhammer, Voulkidis, Gilmore, Shinohara, Kawai, Boeni, Mayr, Meixner, Grazioli, and Nadig are cited to sow related inventions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML  
  
John Sipos  
Primary Examiner  
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